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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
10/848,809	05/19/2004	Steven C. Black	15854.3.1	6228		
22913	7590	02/02/2010	EXAMINER			
Workman Nydegger 1000 Eagle Gate Tower 60 East South Temple Salt Lake City, UT 84111				SENSENIG, SHAUN D		
ART UNIT		PAPER NUMBER				
3629						
MAIL DATE		DELIVERY MODE				
02/02/2010		PAPER				

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/848,809

Filing Date: May 19, 2004

Appellants(s): BLACK ET AL.

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John T. Gadd  
For Appellants

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed December 7, 2009 appealing from the Office action mailed July 6, 2009.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The Appellants' statement of the status of amendments after final rejection contained in the brief is correct.

Although Advisory Action dated December 1, 2009 failed to indicate so, the amendment after final rejection filed on October 6, 2009 has been entered.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The Appellants' statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Exall et al. (Patent No. US 7,330, 817 B1)

Peace Corps Appellants Toolkit (Peace Corps; Peace Corps Appellants Toolkit.

<<http://web.archive.org/web/20011213215823/www.peacecorps.gov/indexf.cfm>>

12/17/01 12/15/08 (retrieved from the Wayback Machine as of 12/17/01)

Warady et al. (Patent Number 6,067,522)

Jinks (Pub. No. US 2002/0055862 A1)

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Objections***

1. **Claim 35** is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Appellants is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 35 cites material regarding the order of forms being presented based on changes in legal criteria, which is also found in Claim 1. No new limitations are present in Claim 35.

***Claim Rejections - 35 USC § 101***

2. **Claims 1-10 and 29-30 and 32-35** are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to

examiners is that a § 101 process must entail the use of a specific machine or transformation of an article which must impose meaningful limits on the claim's scope to impart patent-eligibility. See *Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972). Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Parker v. Flook*, 437 U.S. 584, 590 (1978). The "client-server environment", as presented in claim 1, performs the insignificant extra-solution activity of generating without performing any processing activities. Moreover, while the claimed process contains physical steps (generating, making, updating), it does not involve transforming an article into a different state or thing. Therefore, Appellants' claim is not drawn to patent-eligible subject matter under § 101.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. **Claims 1-11, 29-30, 32, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Exall et al. (Patent No. US 7,330, 817 B1) (hereafter referred to as Exall) in view of Peace Corps Appellants Toolkit (hereafter referred to as PC).**
6. In regards to **Claims 1, 11, and 35**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, the method comprising:  
generating a plurality of human resources compliance forms that substantially conform to predetermined legal criteria; (Column 4, lines 54-67 and Column 5, lines 1-7, *shows the creation of forms in relation to predetermined legal criteria*)  
updating, as required, at least one of the plurality of human resources compliance forms to conform with a change in the legal criteria; (Column 5, lines 1-7, *shows updates based on changes in legal criteria*)  
making the updated human resources compliance form available to the client.  
(Column 4, lines 54-67 and Column 5, lines 1-7, *shows forms being updated while currently available to the client*)  
Exall discloses making the plurality of human resources compliance forms available to a client (Column 4, lines 54-67 and Column 5, lines 1-7, *shows forms being available to the client*) and legal criteria data corresponding to the client; (Column 5, lines 1-7, *shows legal data relating to the client*). Exall does not explicitly disclose activities performed in a specific order based on status and legal requirements, however

PC teaches activities performed in a specific order based on status and legal requirements. (*Pages 4-9, steps 3 and 5-9 show steps being done in a specific order in which each step must be completed before the next one is started based on status and legal requirements*)

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Exall so as to have included the activities performed in a specific order based on status and legal requirements taught by PC in order to ensure efficiency and reliability by not allowing the client to perform activities in an order that is well-known to be legally non-compliant or to perform activities in an order that is considered to be procedurally inefficient or unnecessary, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Neither Exall nor PC explicitly disclose determining whether the change in the legal criteria requires a corresponding change in the order in which a form is presented to the client and presenting the forms in that order, however, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the system of Exall so as to have included determining whether the change in the legal criteria requires a corresponding change in the order in which a form is presented to the client and presenting the forms in that order (See KSR [127 S Ct. at 1739] "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.") in order to ensure efficiency and reliability by not allowing the client to perform activities in an order that is

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legally non-compliant or to perform activities in an order that is considered to be procedurally inefficient or unnecessary, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

7. In regards to **Claim 2**, Exall discloses wherein forms related to the screening of applicants and the hiring of employees are made available (Abstract, lines 2-3; Column 4, lines 54-67; and Column 5, lines 1-7), but Exall does not disclose the specific forms that are provided (a first rejection letter form, a second rejection letter form, a conditional acceptance letter form, a drug screening authorization form, background screening authorization form, a third rejection letter form, an intent-not-to-hire letter form, and a new hire document). However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have included these or similar forms as available resources since the actions they represent are common among human resource functions.

8. In regards to **Claim 3**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the predetermined legal criteria and human resources compliance forms correspond to employee hiring. (Column 16, lines 34-46)

9. In regards to **Claim 4**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the predetermined legal criteria and human resources compliance forms correspond to employee termination. (Column 20, line 1)

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10. In regards to **Claim 5**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the predetermined legal criteria and human resources compliance forms correspond to employee training. (Column 4, lines 12-16)

11. In regards to **Claim 6**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the predetermined legal criteria and human resources compliance forms correspond to employee compensation. (Column 2, lines 60-63 and Column 22, lines 23-24)

12. In regards to **Claim 7**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the status data corresponds to at least one of a client characteristic and an employee of the client. (Column 9, lines 7-21)

13. In regards to **Claim 8**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein generating the human resources compliance forms includes receiving the status data from the client. (Column 9, lines 7-21)

14. In regards to **Claim 9**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the status data is received from a third party. (Column 9, lines 7-21)

15. In regards to **Claim 10**, Exall discloses:

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In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the status data is received from a third party resource. (Column 9, lines 7-21)

16. In regards to **Claim 29**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein updating, as required, at least one of the plurality of human resources compliance forms to conform with a change in the legal criteria comprises dynamically updating, in automatic response to a determination that a change in a law has occurred, at least one of the plurality of human resources compliance forms to accommodate the change in the law. (Column 4, lines 54-67 and Column 5, lines 1-7)

17. In regards to **Claim 30**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein updating, as required, at least one of the plurality of human resources compliance forms to conform with a change in the legal criteria comprises: automatically determining that the change in a law created a conflict with an existing one of the plurality of human resources compliance forms; and automatically updating the existing human resources compliance form to accommodate the change in the law. (Column 4, lines 54-67 and Column 5, lines 1-7)

18. In regards to **Claim 32**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, further comprising: generating a notice regarding

the change in the legal criteria; and making the notice available to the client. (Column 9, lines 21-40)

19. In regards to **Claim 33**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the notice advises the client of the change in the legal criteria and instructs the client of the steps that should be taken to remain compliant with the change in the legal criteria. (Column 9, lines 21-40)

20. **Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Exall in view of PC in further view of Warady et al. (Patent Number 6,067,522) (hereafter referred to as Warady).**

21. In regards to **Claim 15**, Exall discloses:

In a client-server environment, a user interface provided by a server for facilitating the management of human resources compliance efforts, the user interface comprising:

an interface configured to provide a client access to a plurality of forms for use in a human resources process, wherein client access to the forms is controlled at least in part by legal criteria governing the human resources process, and wherein at least one of the forms is dynamically updated by the server to reflect changes in the legal criteria; (Column 4, lines 54-67 and Column 5, lines 1-7, *shows forms in relation to predetermined legal criteria, shows forms being available to the client, and shows updates based on changes in legal criteria* and Column 6, lines 62-63, *shows an interface used to interact with the system*)

an interface configured to reflect changes in the legal criteria; (Column 4, lines 16-20, *shows capabilities to monitor legal criteria changes*, and Column 6, lines 62-63, *shows an interface used to interact with the system*) and

Exall does not explicitly disclose materials available in a specific order based on status and legal requirements, however PC teaches materials available in a specific order based on status and legal requirements. (Pages 4-9, *steps 3 and 5-9 show steps being done in a specific order in which each step must be completed before the next one is started based on status and legal requirements*)

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Exall so as to have included the materials available in a specific order based on status and legal requirements taught by PC in order to ensure efficiency and reliability by not allowing the client to perform activities in an order that is well-known to be legally non-compliant or to perform activities in an order that is considered to be procedurally inefficient or unnecessary, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Neither Exall nor PC explicitly disclose updating the order in which forms are based on changes in legal criteria, however, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the system of Exall so as to have included updating the order in which forms are based on changes in legal criteria in the order in which a form is presented to the client and presenting the forms in that order (See KSR [127 S Ct. at 1739] "The combination of familiar elements

according to known methods is likely to be obvious when it does no more than yield predictable results.") in order to ensure efficiency and reliability by not allowing the client to perform activities in an order that is legally non-compliant or to perform activities in an order that is considered to be procedurally inefficient or unnecessary, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Neither Exall nor PC explicitly disclose an interface configured to reflect status data of employees working for the client including form customization for the employee, however Warady teaches:

an interface configured to reflect status data of employees working for the client, the at least one updated form being customized for at least one of the employees based on the status of the at least one employee. (Column 1, lines 45-46, *shows customization of forms for employees*; Column 5, lines 12-13, *shows employee files containing status information*; Column 8, lines 27-31, *shows an interface to manage employee files*; and Column 9, lines 47-58, *shows employee data being updated by an external entity*)

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the system of Exall so as to have included an interface configured to reflect status data of employees working for the client including form customization for the employee taught by Warady in order to increase efficiency and usability by allowing users to monitor progression and by tailoring materials to the users specific needs, since doing so could be performed readily and easily by any

person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

*Examiner's Note:* Examiner points out that the prior art pertains to an interface capable of showing multiple types of information and/or separate interfaces intended for different types of information, however, these would be equivalent to an interface containing three portions due to the fact that they present equivalent information differing only by visual format .

22. In regards to **Claim 16**, Neither Exall nor PC explicitly disclose the ability of a client to modify data used to auto-populate forms, however it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the system of Exall so as to have included the ability of a client to modify data used to auto-populate forms in order to reduce errors and any resulting problems by retaining the ability to correct any errors, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

23. In regards to **Claim 17**, Exall discloses:

In a client-server environment, a user interface provided by a server for facilitating the management of human resources compliance efforts, wherein the forms are customized according to client characteristics. (Column 2, lines 25-27)

24. In regards to **Claim 18**, Exall discloses:

In a client-server environment, a user interface provided by a server for facilitating the management of human resources compliance efforts, further including an

interface portion configured to display training materials and to track training progress.  
(Column 4, lines 12-16; Column 5, lines 10-12; and Column 12, lines 40-42)

**25. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Exall in view of PC in further view of Jinks (Pub. No. US 2002/0055862 A1).**

In regards to **Claim 34**, Exall discloses: making the at least one updated form available to the client. (Column 4, lines 54-67 and Column 5, lines 1-7t)

Neither Exall nor PC explicitly disclose auto-populating the forms with data, however Jinks teaches auto-populating the forms with data; ([0035], line 12)

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the system of Exall so as to have included auto-populating the forms with data as taught by PC in order to increase usability and efficiency by reducing redundant work, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

**(10) Response to Argument**

**A. Issue 1: Whether claims 1-10, 29-30, and 32-34 are unpatentable, under 35 U.S.C. §101, as being drawn to patent-ineligible subject matter.**

**i. The Examiner erred in asserting that the "human resources compliance form" of claim 1 does not qualify as an "article" under the Interim Examination Instructions**

Based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 transformation must be a "*physical transformation*". Appellants argues that a physical human resource compliance form is scanned to create an electronic human resource compliance form. The simple

scanning of a document into an electronic document/image does not represent a physical transformation.

**ii. The Examiner erred in asserting that claim 1 does not recite acts that "particularly transform a particular article to a different state or thing" under the Interim Examination Instructions**

Based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 transformation must be a "*physical transformation*". Appellants argues that the *updating of data* in an electronic human resource compliance form represents "transformation". The simple *updating of data* of in an electronic document does not represent a physical transformation.

**B. Issue 2: Whether claims 1-11, 29-30, 32-33 are unpatentable, under 35 U.S.C. §103(a), as being obvious over U.S. Patent No. 7,330,817 to Exall et al ("Exall") in view of Peace Corps Appellants Toolkit ("PC").**

**i. Claims 1 and 11**

Appellants argue that Examiner conceded in the final office action that PC does not teach "order change elements". This is **incorrect**. Examiner retained that PC teaches "*order change elements*" (Final Office Action, P 6, lines 18-21) and added a rejection (in response to the amendments) in which PC does not teach "*the determination of order change elements*" (Final Office Action, P 6, lines 30-32).

Appellants also argue that Examiner relies on *official notice* to reject the claim(s). Examiner **did not take official notice** on these or any other claims in this application.

**a. The Examiner has failed to demonstrate that the facts of the cited legal precedent are similar to those in the present application**

Appellants argue that Examiner has failed to demonstrate any similarity between the facts of KSR and the facts in the present application. The argued claims and related

35 U.S.C. §103 rejections are described in detail here (including an explanation of KSR rational(s)).

*Claims 1 and 11:*

Appellants claim “*generating a plurality of human resources compliance forms that substantially conform to predetermined legal criteria.*” Exall discloses “...one or more **compliance reports are generated...**” (Column 4, lines 54-55) and “...**process documentation creation...**” (Column 4, line 63). Reports being generated and process documentation being created shows methods in which **forms can be created for human resource compliance**, forms being usable to **enter report data** and/or **documentation information** for processes. Exall also discloses “*reports...suitable for admission into evidence in a legal proceeding.*” (Column 4, lines 60-61) and “...*documentation may be...updated ...as needed based upon developments in employment laws...*” (Column 5, lines 3-5). Exall shows that the generated reports and documentation are developed to **substantially conform to predetermined legal criteria** and also specifically states that reports/documentation are used with actions and processes (Column 4, lines 62-67) that “...**impact...employment law compliance...**” (Column 4, line 64) and are used to “...**minimize non-compliance...**” (Column 4, lines 65-66).

Appellants claim “*making the plurality of human resources compliance forms available to a client.*” Exall discloses “*The generated...reports are sent to...report agents of the employer.*” (Column 4, lines 58-59). The **reports are made available to**

(as well as directly provided to) the client (in this case the staff of the employer using the system).

Appellants claim “*updating, as required, at least one of the plurality of human resources compliance forms to conform with a change in the legal criteria.*” Exall discloses “...documentation may be...**updated**...as needed **based upon developments in employment laws...**” (Column 5, lines 3-5) showing that *developments (changes) in law directly effect the updating of documents.*

Appellants claim “...the plurality of human resources compliance forms available...*in an order that is dynamically controlled at least in part by the legal criteria and status data corresponding to the client.*” PC teaches **activities being performed in a specific order based on status and legal criteria** (Pages 4-9, Steps 3 and 5-9) (some steps in the PC process have corresponding forms to be filled out as part of that step). These steps are performed in a *specific order based on status and legal criteria* such as which steps the applicant has completed and for which steps the applicant has been approved. Each step must be completed and the applicant approved for the requirements covered by said step before moving on to the next. Each step represents **requirements for eligibility** that are **determined by legal requirements for eligibility**. Any changes in legal requirements pertaining to an applicant’s eligibility for participation in the program could have an effect on the nature and/or order of these steps. The combination of the elements disclosed by Exall and Pc are obvious as applied to KSR (**Combining prior art elements according to known methods to yield predictable results**):

(1) Although not in a single reference, **all of the above elements are present in the prior art.**

(2) Any person of ordinary skill in the art could have **combined these elements** in way such that **each element would perform the same function** it had performed separate from the other elements. *The combination of these elements has no effect on how each individual element is performed.*

(3) Any person of ordinary skill in the art could have combined these elements in way such that said person would have **been able to predict the results** of that combination without undue experimentation. The combination of **items developed and updated based on legal criteria** with **items that are presented in an order based on legal criteria** would yield a **predictable result** of the *order of presentation being altered based on an update of legal criteria.*

Appellants claim “**determining whether the change in the legal criteria requires a corresponding change in the order in which updated human resource compliance form is presented to the client.**” PC teaches **activities being performed in a specific order based on status and legal criteria** (Pages 4-9, Steps 3 and 5-9) (some steps in the PC process have corresponding forms to be filled out as part of that step). These steps are performed in a *specific order based on status and legal criteria* such as which steps the applicant has completed and for which steps the applicant has been approved. Each step must be completed and the applicant approved for the requirements covered by said step before moving on to the next. Each step represents **requirements for eligibility** that are **determined by legal requirements for eligibility.** Any changes in

legal requirements pertaining to an applicant's eligibility for participation in the program could have an effect on the nature and/or order of these steps. The combination of the elements disclosed by Exall and Pc are obvious as applied to KSR (**Combining prior art elements according to known methods to yield predictable results/next logical step**):

(1) The prior art shows both **activities being performed in a specific order based on status and legal criteria** and **resources being updated as needed based upon developments in employment laws**. With both of these elements, a logical step between *resources being updated as needed based upon developments in employment laws* and *activities being performed in a specific order based on status and legal criteria* would be that the **user/system determines what these changes are before implementing them**. It would be difficult to implement these changes prior to determining what the changes are.

(2) Any person of ordinary skill in the art could have **combined these elements** in way such that **each element would perform the same function** it had performed separate from the other elements. *The combination of these elements has no effect on how each individual element is performed.*

(3) Any person of ordinary skill in the art could have combined these elements in way such that said person would have **been able to predict the results** of that combination without undue experimentation. The combination of **items developed and updated based on legal criteria** with **items that are presented in an order based on legal criteria** and additionally with **a user/system determining what changes have**

***occurred before implementing them would yield a predictable result of the order of presentation being altered based on an update of legal criteria.***

- b. The Examiner has improperly taken official notice in a final office action where the purported facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

Appellants argues that Examiner relies on *official notice* to reject the claim(s).

Examiner did not take official notice on these or any other claims in this application.

**ii. Claims 32 and 33**

*Claim 32:*

Appellants claim “generating a notice regarding the change in the legal in the legal criteria.” Exall discloses a system in which content “...is provided and maintained by a third party information source.” (Column 9, lines 16-17) which can be a “...employment law information source...” (Column 9, lines 27-28) (“sources” is associated with “servers” in Column 9, line 25-28). This content can be “...updated on a periodic basis, as required by **changes in law...**” (Column 9, line 19). The system then may “...retrieve content from employment law information servers...and in turn **passing the content directly to the user...**” When a user directly receives *updated content*, the **receipt of that content would serve as a notice to the user** that content has been updated.

Appellants claim “making the notice available to the client.” As seen above, the **receipt of updated content serves as a notice to the user**, therefore **possession of that updated content would make the notice available** to (and in this case already in the possession of) the user.

*Claim 33:*

Appellants claim “*the notice advises the client of the change in legal criteria and instructs the client of the steps that should be taken to remain compliant with the change in the legal criteria.*” As seen in the explanation of Claim 32 above, the *notice received by the user consists of the actual updated employment law information content.* This content would contain ***the legal information and guidelines*** that are part of the law(s) and therefore would act as ***advisories and instructions on how to remain compliant*** with the laws. By following the legal information that they have in their possession, the user(s) will remain compliant.

**C. Issue 3: Whether claims 15-18 are unpatentable, under 35 U.S.C. §103(a), as being obvious over Exall in view of PC, and further in view of U.S. Patent Number 6,067,522 to Warady et al. (" Warady").**

Appellants argue that Examiner conceded in the final office action that PC does not teach “order change elements”. This is **incorrect**. Examiner retained that PC teaches “*order change elements*” (Final Office Action, P 6, lines 18-21) and added a rejection (in response to the amendments) in which PC does not teach “*the determination of order change elements*” (Final Office Action, P 6, lines 30-32).

Appellants also argue that Examiner relies on *official notice* to reject the claim(s). Examiner **did not take official notice** on these or any other claims in this application.

**i. The Examiner has failed to demonstrate that the facts of the cited legal precedent are similar to those in the present application**

Appellants argue that Examiner has failed to demonstrate any similarity between the facts of KSR and the facts in the present application. The argued claims and related

U.S.C. §103 rejections are described in detail here (including an explanation of KSR rational(s)).

*Claims 15:*

*The elements that were combined through the 35 U.S.C. §103 rejections for Claim 15 and the rational for doing so are the same as that which was used for Claims 1 and 11. Please refer to the explanation of Claims 1 and 11 for details (Section B. a.).*

**ii. The Examiner has improperly taken official notice in a final office action where the purported facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known**

Appellants argue that Examiner relies on *official notice* to reject the claim(s).

Examiner did not take official notice on these or any other claims in this application.

**D. Issue 4: Whether claim 34 is unpatentable, under 35 U.S.C. §103(a), as being obvious over Exall in view of PC, and further in view of U.S. Patent Publication No. 2002/0055862 to Jinks ("Jinks").**

Appellants argue that Claim 34 is problematic for the same reasons as Claim 1 and directs the attention of the Board to Appellants' discussion of Claim 1. Likewise, **Examiner directs the attention of the Board to Examiner's responses to Appellants' arguments in regards to Claim 1 (above).**

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/S. S./

Examiner, Art Unit 3629

Conferees:

John Weiss

/JOHN G. WEISS/

Supervisory Patent Examiner, Art Unit 3629

Vincent Millin/vm/

Appeals Practice Specialist